

REMARKS

Claims 1-6 are pending in the application. Claims 3 and 4 are withdrawn from consideration as being directed to non-elected subject matter.

35 U.S.C. § 103:

Claims 1, 2, 5 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicants' admitted prior art in view of U.S. Patent 6,838,051 (Marquiss).

As an initial matter, Applicants point out to the Examiner that rejections under 35 U.S.C. § 103(a) are proper only when the applied references teach or suggest each of the recited features. Claim 1 recites, *inter alia*:

"a rotating incubator rotor provided with a plurality of element chambers which are arranged along the outer periphery of the incubator rotor and each of which accommodates a dry analysis element spotted with a sample and incubates the dry analysis element and a light measuring means having a light measuring head which measures the optical density of the dry analysis element."

The Examiner has not applied a reference against the above noted features, but instead alleges that claim 1 is in Jepson format such that these features are known. Applicants submit that claim 1 is not in Jepson format. Accordingly, based on this reason alone, the rejection of claim 1 under 35 U.S.C. § 103(a) should be withdrawn, along with the rejection of dependent claims 2, 5 and 6, at least due to their dependency.

Turning to the section entitled "Response to Arguments," the Examiner sets forth two discussions of Marquiss. The first one presumes that the claimed "correction means" is not

interpreted under 35 U.S.C. §112, sixth paragraph; while the Examiner's second discussion addresses this feature as if it were interpreted under 35 U.S.C. §112, sixth paragraph.

As an initial matter, Applicants submit that under either of the Examiner's interpretations, each feature corresponding to the claimed correction means, in claim 1, is neither taught nor suggested by Marquiss. Further, Applicants do not concede as to whether the recited correction means invokes 35 U.S.C. §112, sixth paragraph.

Turning to the Examiner's first analysis (i.e., first paragraph on page 4, of the Office Action), the Examiner relies on element 5122 of Marquiss for disclosing a light monitor which allegedly provides a correction means. Applicants respectfully point out that a functional feature is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). Therefore, such a recitation must be evaluated and considered, just like any other feature of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used (see MPEP §2173.05(g)).

Turning to claim 1, it is recited that:

"wherein the light measuring means is provided with a correction means which compensates for fluctuation in the value of the optical density of the dry analysis element in each of the element chambers as measured by the light measuring head generated due to a fluctuation in the distance between the light measuring head and the element chamber on the basis of a correction value which has been stored in the correction means, element chamber by element chamber."

Marquiss does not disclose these features. Accordingly, Applicants submit that the recitation of "correction means" in claim 1 cannot be read in a vacuum while ignoring the associated features, which are emphasized above in italics.

Turning to the Examiner's interpretation of "correction means" as being "means plus function," Applicants similarly submit that the claimed features are neither taught nor suggested. The Examiner asserts that she finds "no significant (or patentable) difference in a correction of fluctuations from the analysis element versus a correction in fluctuations from the light source." Applicants respectfully point out that rejections are not based on whether or not the Examiner deems a feature to be "significant" or not. Instead, it is the duty of the Office to provide a reference that either teaches or suggests each feature provided in the claim. (See MPEP §2143).

Further, there is clearly a difference between what is disclosed in Marquiss and that recited in claim 1. For example, claim 1 is drawn to a novel combination of elements that provides an incubator with features not provided by the applied art. Prior art incubators have suffered from the inability to accurately monitor a distance between a dry analysis element and a light measuring head and, thus, result in inaccurate reading. Marquiss neither acknowledges nor provides any teaching regarding a distance between the analyzed element and the light measuring head. In particular, there is no mention of a distance between the sample 5126 in Marquiss and the applied light monitor 5122.

In summary, Marquiss fails to disclose each feature recited in claim 1, regarding at least the rotating incubator including a plurality of element chambers, in addition to the recited light measuring means that is provided with a correction means, as particularly defined in the claim.

Furthermore, claim 2 recites that the correction means is operable to set the correction value for each element chamber. By reciting that the correction means is "operable" to provide the claimed features, the physical aspects of claim 2 are inherently defined. Thus, the Examiner is requested to address each feature of claim 2. Moreover, claim 5 recites that the correction

RESPONSE UNDER 37 C.F.R. § 1.116
U.S. APPLICATION NO. 10/042,319

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means receives a signal from the position detection section which represents a position of one of a plurality of element chambers. Applicants also submit that this feature is not taught or suggested by the applied references.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

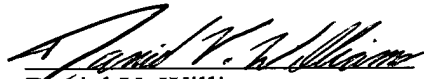
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